

AMENDMENTS TO THE DRAWING

The Office deemed the Drawings to be deficient in the they do not expressly set forth a composite wall and a boat. The applicant disagrees. Claims 13-17 to which the Office finds objection, are method claims. There is no requirements in the patent law, the MPEP or elsewhere to show the physical elements of work pieces in method claims.

As to the first and second parts of the adhesive, claim 6, those distinct elements are very clearly shown in Figures 5! – 5E as elements 571 and 572.

As to the nib in claim 9, the Office's attention is drawn to the radially extending lines on the underside of the head 210 in Figure 2. The Drawing is amended herein to number those nibs as element 212.

Formal drawings will be prepared upon receipt of notice of allowance.

REMARKS/ARGUMENTS**Drawing**

The applicant includes revised drawing pages, and will provide formal drawings as needed upon notice of allowance.

Double Patenting

The Office rejected claim 13 as comprising obviousness-type double patenting over claim 18 of App. No. 19.741279. Since claim 13 is dependent on claim 1 and claim 1 is significantly amended herein, the applicant considers the rejection to have been obviated. If the Office retains the rejection in view of the amendments herein, the applicant will file a terminal disclaimer.

35 USC 102

Claims 1, 2, 6, 8, and 9 were rejected as being anticipated by Nystrom (US 5746039). The applicant disagrees with the Office because he disagrees with the idea that dry self-curing adhesive is inherent in the prior art. Inherency requires that the claimed subject matter is the only possible way of practicing the disclosed subject matter.¹ In this instance it would be entirely possible to provide dry self-curing adhesive that is not microencapsulated, merely by physically separating the two parts. Thus, the cited references are insufficient to establish inherency of a dry self-curing adhesive.

All of that, however, is mooted by the amendments herein, which recite as additional elements hi/low threads disposed about a shank wherein at least some portion of the shaft is unthreaded between the threads and the head. There doesn't seem to be any prior art having a combination of self-drilling point, hi-low threads, and a significant portion of bare shank between the threads and the head. All of the remaining claims are allowable as being dependent on allowable claim 1.

¹ The fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient ", citing *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

No new matter is introduced by the amendments. Fig. 3D clearly shows that the distance along the shank between the threads and the head is greater than the thickness of the head, and also greater than the length of the self-drilling tip. The specification text corresponding to Figure 3D describes the thickness of the head as $L_2 = 1.4$ mm, and the length of the self-drilling tip as $L_4 = 6.35$ mm, see page 6, lines 19 – 24. These numbers provide the support for the specific lengths given in amended claim 1 and added claim 18. Amendment to claim 6 regarding the adhesive being discontinuously disposed about the threads is supported at spec. page 9, lines 1-15. Amendment to claim 8 regarding the adhesive being disposed about the threads but not touching the head is supported in the Figures. Amendment to claim 10 regarding the countersunk nature of the head is supported by Figure 2. The limitation to added claim 19 regarding the adhesive being disposed along the length of the threads is supported by Figure 2 and accompanying text.

Claims 1, 4-6, 8, 9, and 13 were rejected as being anticipated by Toback (US 5304023). The same arguments apply here as were set forth above with respect to Nystrom. There doesn't seem to be any prior art having a combination of self-drilling point, hi-low threads, and a significant portion of bare shank between the threads and the head. In addition, the applicant asks that the examiner focus on the limitation of claim 8 that the adhesive does not contact the head., and on the limitation of claim 10 that the head is a countersunk type of head. The prior art references contemplate bunching up the adhesive at the head end of the shank.

35 USC 103

Claims 3 and 7 were rejected as being obvious over Nystrom (US 5746039). Those rejections are obviated by amendment to parent claim 1. Nystrom fails to teach, suggest, or motivate one of ordinary skill in the art to provide a combination of self-drilling point, hi-low threads, and a significant portion of bare shank between the threads and the head.

Claims 10 ~ 11, 12, and 14 ~ 17 were rejected as being obvious over a combination of Toback and supposedly admitted prior art. Those rejections are also obviated by amendment to parent claim 1. Nystrom fails to teach, suggest, or motivate one of ordinary skill in the art to provide a combination of self-drilling point, hi-low threads, and a significant portion of bare shank between the threads and the head. *In addition*, the Office misreads the quoted statement

from the specification. The applicant is not admitting that it is *known* to use high-low threads for improving connections in wood and sheet metal. He is merely admitting that high-low threads are *somewhat useful* for improving connections in wood and sheet metal. Still further, there is no admission that there is any known or suggested benefit in combining high-low threads with an adhesive. Indeed, a major thrust of the patent application is that such combination is novel!

Moreover, the Office cannot just waive its hands and state that things are obvious. It must set forth a *prima facie case of obviousness*, which requires that three basic criteria are met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim recitations. *The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.* The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. [M.P.E.P. §2142]. In this instance the Office failed completely to set forth a *prima facie case of obviousness*. The Office's entire obviousness analysis is based on impermissible hindsight.

All of the obviousness rejections should be withdrawn. The rejected claims are allowable as being dependent on allowable parent claim(s), and the Office failed to satisfy its burden of establishing a *prima facie case of obviousness*.

Request For Allowance

Claims 1 – 19 are pending in this application. The applicant requests allowance of all pending claims.

///

Respectfully submitted,
RUTAN & TUCKER

By 
Robert D. Fish
Reg. No. 33880

Rutan & Tucker
611 Anton Blvd., 14th Floor
Costa Mesa, CA 92626-1931
Telephone (714) 641-5100
Fax (714) 546-9035